

ARGUMENTS/REMARKS

Applicants would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Claims 1-5, 9-18 and 21 stand pending in this application. Claims 1, 9, 13, and 18 have been amended and claim 21 is a new claim. It is believed that the application is now in condition for allowance. Reconsideration is respectfully requested.

Claims 13 -15 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which applicant regards as the invention. Claim 13 recited the limitation "the at least one opening" in lines 2-3. The Examiner stated that there was insufficient antecedent basis for this limitation in the claim. Claims 14 and 15 were rejected as being dependent upon a rejected base claim. Claim 13 has been amended to overcome the rejection. Applicant therefore respectfully requests withdrawal of the rejection of claims 13, 14 and 15.

Claim 1 was rejected under 35 U.S.C. §102(e) as being anticipated by Huska (U.S. 6,659,043). However, because Huska fails to disclose all of the limitations of the currently amended claim 1, Huska does not anticipate claim 1, which is now in condition for allowance.

Claim 1 has been amended to recite that "the inlet port is rotatably coupled to the interior portions of the modular water flow system." Huska clearly does not provide any teaching or suggestion of an overwall assembly which contains a link which contains an inlet port and an outlet port wherein the inlet port is rotatably coupled to the interior portion of the modular water flow system as claimed in claim 1. As such, claim 1 is now in condition for allowance without further prosecution. In the rejection of claim 9, the Examiner states that rotatably coupled parts are inherently taught by Huska at the point where the link meets element #45. Although item #45 is coupled to the "link," it is not rotatably coupled. In particular, nothing in the drawings or specification show or state that it is rotatable. To be inherent, it must necessarily be rotatable. Accordingly, because Huska does not disclose all the elements of currently amended claim 1, Huska does not anticipate claim 1.

Furthermore, the Huska coupling does not facilitate positioning of the modular water flow system as the new claim 21 recites. New claim 21 is allowable because Huska does not disclose a rotatable coupling that facilitates positioning of the modular water flow system.

Independent claim 18 was rejected under 35 U.S.C. §102(e) as being anticipated by Huska for the same reason that claim 1 was rejected. Claim 18 has been amended to incorporate limitations of claim 20. Claim 20 was rejected for the same reason that claim 9 was rejected. Namely, the Examiner states that rotatably coupled ports are inherently taught by Huska at the point where the link meets element #45. However, as discussed above, nothing in the drawings or specification show or state that the coupling is rotatable. Moreover, it does not swivel to facilitate positioning of the water flow system as claimed in claim 18. Therefore, for the reasons discussed above, claim 1 and claim 18 are not anticipated by Huska and are in condition for allowance.

Claim 1 was rejected under § 103(a) as being unpatentable over Gilkey in

view of Sy. However, because the currently amended claim 1 is not obvious, it should be allowed for at least the following reasons.

Gilkey in view of Sy fails to disclose every limitation of the currently amended claim 1. In fact, at least two elements of the amended claim 1 are not disclosed in Gilkey in view of Sy. In particular, Gilkey does not disclose a valve assembly to manage at least one of the water return system and the water intake system to regulate a flow rate. The Examiner states that Sy teaches a water return rate adjusting means for an aquarium (Sy #156 and col. 9 lines 29-31). However, Sy does not teach a water return rate adjusting means. The valve #156 is a control valve used to "prevent the flow of water during maintenance" (Sy col. 9 lines 29-30). So, even if Gilkey's system is provided with Sy's valve, the combination has an on/off valve used for maintenance, not a valve assembly used to manage flow rate as in the present invention. Put another way, the maintenance valve is used for just that, maintenance. The valve is not used for the regular management of flow rate throughout the aquarium as the valve assembly does in the present invention. Furthermore, there is no suggestion in the reference that such a use is contemplated, either. As such, Sy does not overcome the shortcomings of Gilkey. Thus, claim 1 is patentable over the combination of these references.

Secondly, Gilkey does not disclose an overwall assembly which contains a link which contains an inlet port and an outlet port wherein the inlet port is rotatably coupled to the interior portion of the modular water flow system as claimed in claim 1. In the rejection of claim 9, the Examiner states that, "Gilkey as modified teaches further comprising means for swiveling the connection means (Gilkey #94) to facilitate positioning of the system." However, Gilkey does not disclose ports that are rotatably coupled to allow the overwall assembly units to swivel which facilitate positioning of the water flow system to allow close aquarium-to-wall positioning. Specifically, Gilkey #94 shows a "swivel mounted spray head" (Gilkey col. 6 lines 20-21) which allows the spray head to be swiveled, but does not facilitate positioning of the water flow system to allow close aquarium-to-wall positioning as the rotatable ports do. Accordingly, because of the differences between the applicant's invention as claimed in claim 1 and the patents cited by the Examiner are such that the subject

matter as a whole is not obvious, claim 1 should be allowed over the cited patents.

Finally, the Examiner gives no suggestion or motivation to combine Gilkey with Sy so these items should not be read together in the first place. In this regard, the burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some suggestion or motivation to modify the reference (MPEP §2143.01). The mere fact that references can be combined or modified, alone, is not sufficient to establish prima facie obviousness (Id.). The prior art must also suggest the desirability of the combination (Id.). The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (Id.).

The Examiner has cited no proper support for any such suggestion or motivation for the combination from within the references. Instead, the Examiner merely provides a conclusory statement of benefit provided by the feature of the Sy reference. This is clearly not sufficient to show obviousness.

Instead, the Examiner merely lists an advantage of the Sy reference. No suggestion that such an advantage is desirable is provided from the primary reference. Thus, the Examiner provides a self-fulfilling motivation—nearly every reference shows some advantage, and thus every reference becomes self-motivating. This would make any combination of references obvious by default, and that is clearly NOT the law. Thus, the Examiner must provide something more for a legally sufficient case of motivation.

Independent claim 18 was rejected under 35 U.S.C. §103(a) as being unpatentable over Gilkey in view of Sy for the same reason that claim 1 was rejected. Claim 18 has been amended to incorporate limitations of claim 20 and is now allowable. Because claim 20 was rejected for the same reason that claim 9 was rejected, claim 18 is allowable for the same reasons that claim 1 is allowable. In particular, at least two elements of the amended claim 18 are not disclosed in Gilkey

in view of Sy. Namely, the means for adjusting the water return rate and the means for swiveling the connection means to facilitate positioning of the water flow system are not disclosed in Gilkey in view of Sy. Accordingly, amended claim 18 is now allowable.

Claim 1 was also rejected under § 103(a) as being unpatentable over Gomi in view of Sy. However, because the currently amended claim 1 is not obvious, it should be allowed for at least the following reasons.

Gomi in view of Sy fails to disclose every limitation of the currently amended claim 1. In fact, at least two elements of the amended claim 1 are not disclosed in Gomi in view of Sy. In particular, Gomi does not disclose a valve assembly to manage at least one of the water return system and the water intake system to regulate a flow rate. The Examiner states that Sy teaches a water return rate adjusting means for an aquarium (Sy #156 and col. 9 lines 29-31). However, for the reasons discussed above in connection with the rejection of Gilkey in view of Sy, Sy does not teach a valve assembly to manage at least one of the water return system and the water intake system to regulate a flow rate. Furthermore, also as discussed above, there is no suggestion in the reference that such a use was contemplated. As such, Sy does not overcome the shortcomings of Gomi. Thus, claim 1 is patentable over the combination of these references.

Secondly, Gilkey does not disclose an overwall assembly which contains a link which contains an inlet port and an outlet port wherein the inlet port is rotatably coupled to the interior portion of the modular water flow system as claimed in claim 1. In the rejection of claim 8, the Examiner stated that, "Gomi as modified teaches wherein the inlet port is rotatably coupled to the exterior portion of the modular water flow system (Gomi #31 is rotatably connected to element #18)." However, Gomi does not disclose ports that are rotatably coupled to allow the overwall assembly units to swivel, thus facilitating positioning of the water flow system to allow close aquarium-to-wall positioning. Specifically, Gomi # 31 is a water inlet portion and Gomi #18 is a water introducing pipe which are never even shown or discussed as being connected, let alone rotatably coupled. Furthermore, in Gomi, no inlets or outlets are

shown or described that are rotatably coupled to affect aquarium-to-wall positioning as the inlet port which is rotatably coupled to the interior portion of the modular water flow system does in the present invention. Accordingly, because of the differences between the applicant's invention as claimed in claim 1 and the patents cited by the Examiner are such that the subject matter as a whole is not obvious, claim 1 should be allowed over the cited patents.

Independent claim 18 was rejected under 35 U.S.C. §103(a) as being unpatentable over Gomi in view of Sy for the same reason that claim 1 was rejected. Claim 18 has been amended to incorporate limitations of claim 20 and is now allowable. In the rejection, the Examiner stated that claim 20 was taught in "Gomi where element #18 meets element 8." Although element 18 and 8 are coupled, they are not coupled in a way that would allow a swiveling of the connection means to facilitate positioning of the system. Therefore, for the reasons discussed above in connection with claim 1, the subject matter of the currently amended claim 18 as a whole is not obvious, therefore, claim 18 is in condition for allowance.

Finally, as discussed in connection Gilkey in view of Sy, the Examiner has cited no proper support from within the references or any other such suggestion or motivation for the combination of the references. Instead, the Examiner merely provides a conclusory statement of benefit provided by the feature of the secondary reference. This is clearly not sufficient to show obviousness.

The remaining rejected claims all depend, directly or indirectly, upon independent claims 1 discussed above, and thus are patentable over the reference for at least one of the reasons discussed.

Appl. No. 10/786,695
Amdt. Dated July 15, 2005
Reply to Office action of March 15, 2005

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 35269US1.

Respectfully submitted,

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Date: July 15, 2005